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REMARKS

In response to the final Office Action dated June 15, 2006, Applicant presents the following remarks again traversing the outstanding rejections, as well as a formal amendment to claim 40 to correct an antecedent basis issue and place this claim in better form for purposes of appeal. In light of these remarks and the formal amendment, favorable reconsideration of all claims is respectfully requested.

Initially, Applicant respectfully submits that no basis is provided or otherwise exists for making the most recent Office Action final. Applicant attacked the Examiner's rejections as flawed, including the lack of any substantive basis for rejecting claim 24. The Examiner agreed with the correctness of the Applicant's position in many respects by withdrawing the arguments made in support of the rejections and also by providing a new rejection of claim 24.

Nothing in the rules or MPEP condones making an Office Action final when a *prima facie* rejection is lacking, and then allegedly made for the first time in a subsequent Office Action when a new rejection is made. Quite the contrary, the MPEP at Section 706.07 specifically cautions the examiner to "never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Since Applicant has not had a "full and fair hearing" with respect to the new rejection made, the Examiner should withdraw the finality of the Office Action and give the Applicant an opportunity to respond to the new basis for the rejection and set a proper record for purposes of appeal.

The final Action still contends that claim 1 allegedly violates the strictures of Section 112, first paragraph, because allegedly no "expressed or implied" support exists for the limitation that the thermoplastic polymer coating is "free of random discontinuities." First of all, as Applicant has pointed out several times in previous responses, U.S. Patent law does not in any way mandate "expressed support" for a limitation in the specification.

Rather, it is sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that the inventor had possession of the concept of what is claimed.¹ As Applicant previously pointed out, full support for the “negative” limitations in claim 1 may be found in paragraph 6 of the published application, as well as in the drawing figures (see, e.g., Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering). Since the drawings form part of the written description, “expressed support” for the limitation at issue is thus provided.

Understandably, the Examiner acknowledges that Figure 2 illustrates a layer of thermoplastic polymer 54, but still contends that “the reference” (presumably, Applicant’s specification) “does not teach what are ‘random discontinuities’ as to provide support for the now claimed continuous coating being free of ‘random discontinuities.’” The Examiner essentially wants the Applicant to prove a “negative” by showing where an intentionally omitted structure (random discontinuities) is described in Applicant’s specification or shown in the drawings. Simply put, the polymer layer 54 at issue is “free” of random discontinuities, as illustrated, which is all that the claim requires.

The Action further contends that claim 1 runs afoul of Section 112, first paragraph, because the limitation requiring that the “porosity of the wall covering is reduced significantly” by the polymer coating is allegedly indefinite. This indefiniteness results from the alleged fact that “the claim is NOT comparing to what is the reduced porosity compared to . . . is Applicant trying to refer to a reduction of the porosity of the non-woven fiber tissue or mat instead?”

As Applicant emphasized in the prior response, this statement apparently disregards the fact that claim 1 expressly requires that the porosity of the overall wall covering is reduced by the polymer coating covering the non-woven fiber tissue or mat. No reasonable interpretation of the claim or reading of the language would cause a skilled artisan to query whether it is the wall covering or the fiber tissue or mat that has reduced

¹ *In re Anderson*, 471 F.2d 1237, 176 USPQ 331(CCPA1973).

porosity. Indeed, the Examiner's interpretation is strained, since the porosity of the fiber tissue or mat itself remains unchanged as a result of the polymer covering, even though the porosity of the overall wall covering is understandably reduced by the addition of a layer. Since the language used is perfectly clear and would be easily understood by a skilled artisan, it is believed that the claim is definite and the rejection unfounded.

The rejection also seems to suggest that the claim must include a "parameter" that would "allow one of ordinary skill in the art to determine what is the porosity of the claimed material" in order to render the "reduced porosity" limitation definite. Such a requirement is plainly not in accordance with the Manual of Patent Examining Procedure, which explains that "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite." MPEP § 2173.05(b). Here, a skilled artisan would easily understand from the claim language that the porosity of the wall covering is reduced by the addition of the polymer layer without the identification of any parameter. *See, e.g.*, U.S. Patent Nos. 6,890,395, 6,863,686, and 6,771,019. Accordingly, the addition of some precise amount of the reduction achieved, as the Examiner seems to think is required, is unnecessary and would unduly narrow the Applicant's claim.

Moving on to the final rejection of claim 1 based on Jackson, the Examiner seems to disregard Applicant's amendment to require that the claimed coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. In stark and total contrast, Jackson discloses a wall covering having a "porous polymeric ply . . . fused to and supported by a nonwoven substrate ply" (emphasis added). At column 3, lines 51-55, Jackson expressly defines "porous" and "continuous" synonymously as referring to "the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering," not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a

definition of the word "continuous" that does not comport with the ordinary meaning of "uninterrupted."²

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving "continuous" its ordinary meaning) and free of random discontinuities, as shown in Applicant's Figure 2. Quite the contrary, this reference actually teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, "The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (emphasis added)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing), including by way of a roller. Accordingly, claim 1 as amended is believed to distinguish over Jackson, and reconsideration is respectfully requested.

The final Action also maintains the rejections of claims 23-35 based primarily on Jackson "as further evidenced by" the Abstract of WO 95/07946. Reconsideration of these rejections is respectfully requested, since neither reference discloses, teaches, or suggests the invention of claim 23 as a whole, including a layer of paint roller-applied to a thermoplastic polymer coating applied to a non-woven fiber tissue or mat. Since this express element of claim 23 is completely disregarded in the formulation of the rejection, favorable reconsideration of this claim and its progeny is requested.

Despite including all limitations of an allowable base claim, the independent patentability of several of the claims depending from claim 23 over Jackson and the other cited references is also re-emphasized. For example, claims 28 and 29 require a mineral filler to form a non-smooth outer surface. These claims stand rejected based on the

² *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("An inventor may 'be his own lexicographer and . . . give terms uncommon meanings.'"), *but cf. Jonsson v. Stanley Works*, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) ("[w]ords in a claim . . . [are] given their ordinary and accustomed meaning.")

combination of Jackson in view of Ishii et al. (which is again never discussed in the rejection) and Penz et al. Again, the only reason Penz et al. is cited is for its disclosure of a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. The primary contention made in support of the rejection is that "[s]ince both Jackson et al and Penz et al. are from the same field of endeavor, the purpose disclosed by Penz et al. would have been recognized in the pertinent art of Jackson et al."

Applicant respectfully requests reconsideration on the ground that a skilled artisan would not combine Jackson and Penz et al. to arrive at the present invention simply because they are "from the same field of endeavor" or that the "purpose" of one would have been recognized in the "pertinent art" of the other. Specifically, one of ordinary skill in the art would not use the teaching of Penz et al. to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface in combination with Jackson, when in fact Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (see, e.g., col. 2, lines 5-12). Indeed, Jackson extols the desirability of providing a wall covering with a smooth outer surface (see Abstract, line 1), and simply does not contemplate in any way imparting a mineral filler to create a non-smooth outer surface to facilitate roller painting. Incredibly, the Examiner ignores this express teaching and instead contends that both Jackson and Penz et al. "avoid having 'smooth' surfaces," which is simply not true.

When properly interpreted, Jackson thus actually teaches away from the claimed invention, and otherwise fails to motivate a skilled artisan to combine the teachings of Penz et al. to provide a wall covering with a non-smooth outer surface formed using a mineral filler. As observed by the Court of Appeals for the Federal Circuit, "[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents."³

³ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

As for reliance of Ishii et al. in the final rejection of claims 10, 13, 32, 35, and 38-39, and despite Applicant's protestations, absolutely no reason is provided in the final Office Action to explain why a skilled artisan would combine the teachings of this reference with those of Jackson to arrive at the claimed invention. Rather, as in the prior actions, the Examiner simply selects bits and pieces of the prior art teachings as necessary to meet the terms of Applicant's claimed invention. Such a hindsight approach using Applicant's specification and claims as a blueprint has long been rejected as improper.⁴ Absent such a motivation or suggestion in the prior art, the rejections relying on Ishii et al. cannot stand and should be withdrawn.

As noted in the prior response, dependent claim 35 also requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. The primary reference to Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of claim 35, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Given that the Examiner has apparently abandoned her previous position regarding this claim, and fails to identify the limitations of the claim in any of the prior art references, reconsideration of the final rejection is respectfully requested.

With specific regard to claim 39, the Examiner still contends that Jackson "discloses the claimed invention except that it teaches the use of titanium oxide instead of titanium dioxide." Again, this is simply not true, since Jackson fails to disclose, teach, or suggest in any way a mixture of high-density polyethylene or a dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene (all of which form part of the "claimed invention"). The Examiner does not contest Applicant's argument, but instead cites to Ishii et al. as disclosing that titanium dioxide is an equivalent

⁴ *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

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of titanium oxide. Regardless of whether Ishii et al. discloses titanium dioxide, and assuming for the sake of argument that the references are properly combinable, this secondary reference does not otherwise supply the teaching missing from Jackson necessary to render the invention of claim 39 obvious. Accordingly, since the cited combination of references fail to teach every limitation of the claim at issue, a *prima facie* case of obviousness is lacking. Reconsideration is therefore respectfully requested.

The Action still makes a rejection of claim 36 as anticipated by Jackson "as further evidenced by" the Abstract of WO 95/07946. Claim 36 expressly requires a "rigid" fiber tissue or mat. In stark contrast, Jackson teaches that the structure allegedly corresponding to the claimed tissue or mat is "soft." The Examiner previously asserted that "Jackson refers to a soft fabric" which "does not preclude that it forms a rigid structure." Applicant traversed this basis for the anticipation rejection, and the Examiner does not now repeat it in the final Office Action. Moreover, the Examiner fails to identify anywhere in the cited prior art where such a rigid structure is disclosed. Accordingly, it appears upon reconsideration that the anticipation rejection of claim 36 should be withdrawn and this claim held allowable.

Although believed to be allowable as dependent on an allowable base claim, the independent patentability of several of the claims depending from claim 36 is also again emphasized. For instance, dependent claim 2 requires that the outer surface of the polymer coating has a surface tension of at least approximately 30 dynes/cm. In the Office Action, it is acknowledged that Jackson is completely silent as to the claimed surface tension, and no other reference is cited as allegedly supplying this missing teaching. However, the Examiner somehow concludes that such a surface tension would be "inherent to the product of the prior art as it meets all the structural limitations of the present invention."

First of all, the product of the prior art does not meet "all the structural limitations of the present invention." For one, the prior art product does not include the claimed surface tension. In this regard, it is noteworthy that any contention that the claimed surface

tension is a "process step," rather than a structural limitation of the claim, has been withdrawn in the face of Applicant's arguments.

Secondly, the basis for the rejection is contrary not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."⁵ Not only do the steps described for forming the Applicant's claimed wall covering differ completely from those outlined in Jackson, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged in the record, Jackson fails to mention the surface tension of the substrate or any steps taken to alter it, so it cannot possibly anticipate the invention of dependent claim 2.

In the alternative, the Examiner asserts that the "presently claimed function of surface tension . . . would have obviously been provided as a result of the product of" Jackson, apparently relying on a theory of "obviousness by inherency." However, "[t]hat which may be inherent is not necessarily known" and "[o]bviousness cannot be predicated on what is unknown."⁶ Moreover, "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection."⁷ Since Jackson nowhere contemplates, teaches, suggests, or even discusses surface tension to improve the roller paintability of a wall covering, it standing alone cannot possibly make it known to provide a surface tension within the claimed range.

In an effort to refute Applicant's position, the Examiner cites to *In re Skoner*, 186 USPQ 80 (CCPA 1975) for the proposition that "reliance on inherency is not improper even though [sic a] rejection is based on Section 103 instead of Section 102." While that is no doubt the holding of that case, it resulted from a much different factual situation than the one confronting the Examiner. In *Skoner*, the Applicant attempted to claim wire brushing

⁵ See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.

⁶ *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

⁷ *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

to a certain extent to produce a certain surface condition. The prior art reference taught wire brushing generally, but not to the extent required to produce what was claimed. Understandably, the Board was willing to find that wire brushing to the extent claimed was inherent in the reference, given that wire brushing was generally disclosed.

In stark and total contrast, nothing in Jackson even remotely mentions enhancing surface tension using any process, let alone surface tension in general. Thus, it simply cannot be the case that the value suggested by the Applicant as creating advantageous surface characteristics for purposes of roller painting are "inherent" in Jackson. Thus, *Skoner* is inapposite and does not support the Examiner's position.

Looking at the situation from a different perspective, Jackson does not "enable" a skilled artisan to make a wall covering having the claimed surface tension. In the oft-cited decision of *Seymour v. Osborne*,⁸ the United States Supreme Court held that a prior publication must contain a full enabling description in order to constitute anticipation. In doing so, the Court succinctly and aptly explained that:

[I]nventions cannot be superseded by the mere introduction of a ... publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes, the account published to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation.⁹

⁸ *Seymour v. Osborne*, 78 U.S. 516 (U.S. 1871).

⁹ *Id.* at 555. (Emphasis added). See also *In re Paulsen*, 30 F.3d 1475, 1478, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (holding that in order to establish anticipation, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention . . ."). (Emphasis added).

Here, there can be no doubt that Jackson does not describe Applicant's claimed invention sufficiently to place it in possession of a person of ordinary skill in the art, when in fact the particular surface tension claimed by the Applicant is not even remotely mentioned.

Despite being rejected based on the combination of Jackson and Ishii et al. alone, claim 13 is also rejected based on this combination in further view of Melber et al. Again, the primary reference to Jackson specifically requires a plastisol as a component of the polymer coating. By definition, a plastisol includes a plasticizer. Such an added component is clearly excluded by the plain terms of claim 13, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Nothing in Melber et al. supplies the teaching missing from Jackson that would render the claimed composition unpatentable; namely, elimination of the plasticizer. Thus, the combination of references simply cannot teach the invention of claim 13.

Claim 40 requires a thermoplastic polymer with a mineral filler forming a visible outer, non-smooth roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparages a non-smooth outer surface. Despite the contrary admission in the prior Office Action (see page 3, para. c.), the Examiner still rejects as anticipated this claim requiring the exact opposite structure as that taught in the prior art reference cited. Since this administrative government action deprives Applicant's due process rights in fairly having its claimed inventions adjudged for patentability, Applicant respectfully requests that the Examiner reconsider the rejection and either supply the requisite substantial evidence for rejecting the claim, or else withdraw the rejection as unfounded.

In view of the foregoing remarks, Applicant submits that claims 1-13 and 22-40 are allowable over the cited prior art and respectfully requests favorable reconsideration. In the event the Examiner agrees, Applicant will also submit the information necessary to address the Section 112 rejection made with respect to dependent claims 8 and 30. In the meantime, the Examiner is invited to telephone the Applicant's undersigned attorney at the


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number listed below if any unresolved matters remain, and may debit any fees due from
Deposit Account 50-0568.

Respectfully submitted,

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